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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/637,512	08/11/2000	Stanley M. Goldin	42,982 C3-CPA-C	1159

7590

10/22/2002

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EXAMINER

O SULLIVAN, PETER G

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 10/22/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/637,512

Applicant(s)
Goldin et al.

Examiner
Peter O'Sullivan

Art Unit
1621

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 8, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-31 is/are pending in the application.
- 4a) Of the above, claim(s) 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-27 and 29-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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1. Claims 25-31 are pending in this application which should be reviewed for errors.

Applicants are requested to send copies of the references listed in their information disclosure statement with their next response. Claim 28 is held withdrawn from consideration as embracing non-elected subject matter.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 25-27 and 29-31 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas et al. '077 for the reasons of record. Applicants' arguments have been given due consideration but are found non-persuasive. In the generic formula of Douglas et al. X1 and X2 may be substituents overlapping applicants' and R may be aryl. R1-R3 may be hydrogen.

Douglas et al. disclose 1-cyclopropylmethyl-1-(2,6-dichlorophenyl) guanidine which is close to


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applicants' compounds. Douglas et al. disclose the equivalency of cycloalkyl to aryl for their R substituent (s. Col. 1, ll. 64 and 65). That Douglas et al. exemplify an N,N-disubstituted compound shows they clearly contemplated these compounds as part of their invention.

4. Claims 25-27 and 29-31 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Weber et al. '976, taken with Durant et al., '675, and Durant et al., '604. Weber et al. disclose N,N' disubstituted guanidines wherein the substituents may be aryl or aralkyl optionally substituted by applicants' substituents. The compounds of Weber et al. '976 have utility in the treatment of stroke, neurodegenerative diseases, etc., but differ from applicants' compounds as being N,N-disubstituted, not N,N'-disubstituted. Newly cited Durant et al., '675, and Durant et al., '604, are relied on to teach that one nitrogen may have two substituents and the others none or there may be N,N' disubstitution in similar compounds useful in the treatment of stroke, neurodegenerative diseases, etc. It would have been prima facie obvious at the time the invention was made to one of ordinary skill in the art to start with the teaching of the cited references, but to make N,N-disubstituted compounds and to expect them to be useful in the treatment of stroke, neurodegenerative diseases, etc.

5. No claim is allowed.

6. Any inquiry concerning this communication should be directed to Peter O'Sullivan at telephone number (703) 308-4526.


PETER O'SULLIVAN
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GROUP 1200